

**Amendments to the Drawings:**

Please add new Figure 16:

New Figure 16

No new matter has been added to the Figures.

## REMARKS

Claims 2-18, 20-44, 47-49 and 51-52 are pending in the present application. Claims 47-49 have been withdrawn from consideration in view of the restriction requirement now made final. Claims 2, 3, 10, 15, 16, 20, 22 and 37 have been amended. New Figure 16 has been added. The specification has been amended to reflect the addition of new Figure 16. Support for the new Figure may be found in the original claims and in the specification, at least at paragraphs [0093] and [0099]. No new matter was added.

Reexamination of the application and reconsideration of the rejections and objections are respectfully requested in view of the above amendments and the following remarks, which follow the order set forth in the Office Action.

### I. STATUS OF THE APPLICATION

Applicants first respectfully request that the "final" status of the application be withdrawn in view of the following information.

According to the Office Action Summary, this Action is FINAL. The Office Action states as follows:

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

*Office Action mailed November 17, 2006, page 12.* However, the last filed response was a Response to Restriction Requirement filed August 14, 2006. No amendments to the claims were presented therein. The response prior to the response to restriction was an Amendment filed April 25, 2006. However, not all of the claims in the application were amended in that Amendment; rather, independent claim 2 was not amended.

Applicants' representative made a telephone call to the examiner regarding the "final" status of this application in view of the standards set forth in the rules and MPEP regarding the circumstances for making an Office Action final, but did not get an answer regarding this question. Therefore, Applicants respectfully request again herein that the finality of the Office Action be withdrawn as improper under the relevant rules and standards.

The standard from the Manual of Patent Examining Procedure cited by the examiner states:

Under present practice, second or any subsequent actions on the merits shall be final, except where **the examiner introduces a new ground of rejection**

**that is neither necessitated by applicant's amendment of the claims** nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)... Furthermore, **a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art**, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), **of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art**.

MPEP § 706.07(a) (emphasis added). Claim 2 was not amended in the last filed Amendment.<sup>1</sup> However, new art, Hoang et al., U.S. Patent Publication No. 2002/0076255, was cited against claim 2 for the first time in the presently pending Office Action. This art is believed to be cited for the first time on the PTO-892 attached to the Office Action and is not believed to have been previously cited during prosecution of the application.

According to the MPEP as cited above, an office action **will not be made final** if it includes a rejection on newly cited art **of any claim not amended by applicant in spite of the fact that other claims may have been amended....** In view thereof, the status of the present application as "final" is believed to be in error and Applicants respectfully request that the finality of the Office Action be withdrawn.

## **II. OBJECTIONS TO THE DRAWINGS**

The drawings, especially Figures 10-15, were objected to under 37 C.F.R. § 1.83(a) (drawings must show every feature of the invention specified in the claims). Applicants respectfully request that the objections be withdrawn in view of the new figure, the amendments to the claims and the following comments. Each objection will be discussed in the order raised.

### **A. Breaking member on second body portion**

The breaking member on the second body portion as recited in claims 2, 3, 10, 15, 16, 20, 22 and 37 was objected to as not shown in the figures, according to the Office Action. In order to expedite prosecution, the claims have been amended to obviate this objection. In view thereof, Applicants respectfully request that this objection be withdrawn.

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<sup>1</sup> Claim 2 has only been amended once during the entire prosecution and that involved making claim 2 independent by including the recitations of claim 1 from which claim 2 originally depended. *See Amendment filed April 18, 2005.*

B. Camming Surface

The camming surface as recited in claim 20 was objected to as not shown in the figures. New Figure 16 has been provided specifically illustrating the camming surface. The camming surface or inclined ramp is described in detail in paragraph [0093] of the specification. Also, camming surfaces are known to those of skill in the art. Therefore, no new matter was added. In view thereof, Applicants respectfully request that this objection be withdrawn.

C. Plurality of containers

The plurality of containers as recited in claim 37 was objected to as not shown in the figures. This feature is described in detail in the application. However, in order to expedite the prosecution of the application, new Fig. 16 has been added to specifically illustrate a plurality of containers. Support for the new figure may be found at least in paragraph [0099] of the specification. In view thereof, Applicants respectfully request that this objection be withdrawn.

D. Plurality of removable applicator tips

A plurality of removable applicator tips as recited in claim 38 was objected to as not shown in the figures. However, the original figures illustrate more than one removable applicator tip. By way of example, see Figs. 1, 10 and 11. As detailed in the specification, the plurality of applicator tips may be provided in a kit. These tips are described and shown. *See, for example, paragraphs [0044], [0056], [0061], [0066], [0069], and [0083].* The rules are not believed to require that the plurality of tips be shown in the same figure. In view thereof, Applicants respectfully request that this objection be withdrawn.

E. Different amounts of adhesive material

The language in claim 43 reciting at least two of the plurality of containers containing different amounts of adhesive material was objected to as not shown in the figures. Applicants respectfully disagree that such a recitation must be shown in a figure. "Any structural detail that is of sufficient importance to be described should be shown in the drawing." *Ex parte Good*, 1911 C.D. 43, 164 O.G. 739 (Comm'r Pat. 1911), *MPEP* § 608.02(d). The amount of adhesive material is not a "structural" detail. One of ordinary skill in the art readily understands this recitation without need of illustration. In view thereof, Applicants respectfully request that this objection be withdrawn.

#### F. Containers having a different adhesive material

The language in claim 44 reciting a plurality of containers containing different adhesive material was objected to as not shown in the figures. Applicants respectfully disagree that such a recitation must be shown in a figure. "Any structural detail that is of sufficient importance to be described should be shown in the drawing." *Ex parte Good*, 1911 C.D. 43, 164 O.G. 739 (Comm'r Pat. 1911), *MPEP* § 608.02(d). The type of adhesive material is not a "structural" detail. One of ordinary skill in the art readily understands this recitation without need of illustration. In view thereof, Applicants respectfully request that this objection be withdrawn.

### III. OBJECTION TO THE SPECIFICATION

The specification was objected to as failing to provide antecedent basis for the claimed subject matter. The examiner specifically objected to "a second container as recited in claim 4". Applicants respectfully traverse this rejection.

Claim 4 is directed to an applicator/dispenser according to claim 3, further comprising a second container having at least one opening, the second container surrounding the container of adhesive. Antecedent basis is present in the specification at least at paragraphs [0052], [0091], [0092], [0096] and Fig. 15 (by way of example, 447). In view thereof, Applicants respectfully request that this objection be withdrawn.

### IV. REJECTIONS UNDER 35 U.S.C. § 112

#### A. 35 U.S.C. § 112, first paragraph

Claims 2, 3, 10, 15, 16, 20, 22 and 37 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. This rejection is moot in view of the amendments presented above. In view thereof, Applicants respectfully request that this rejection be withdrawn.

#### B. 35 U.S.C. § 112, second paragraph

Claims 2-16, 20-28, 37-44 and 51-52 were rejected under 35 U.S.C. § 112, second paragraph. As to the rejection based on the breaking member arranged on the second body portion, this rejection is moot in view of the amendments presented above. In view thereof, Applicants respectfully request that this rejection be withdrawn.

As to the rejection based on alleged lack of antecedent basis for "at least one of the plug member" as recited in claim 26, Applicants do not understand the rejection. Claim 26 is dependent on claim 23 and recites further comprising an applicator/dispenser tip that is attached to at least one of the plug member, the first body portion and the second body portion. Claim 23 is dependent on claim 22 and further comprises a plug member. Claim 22 recites a first body portion and a second body portion. Thus, each of the elements recited in claim 26 has antecedent basis in the claims upon which claim 26 depends. As recited, the tip is to be attached to at least one of either the plug member, the first body portion or the second body portion. This language is clear and definite. In view thereof, Applicants respectfully request that this rejection be withdrawn.

#### **V. REJECTION UNDER 35 U.S.C. § 102**

Claims 2-5, 20, 21, 22-24, 26-28, 51 and 52 were rejected under 35 U.S.C. § 102(a)/102(e) as being anticipated by Hoang et al., U.S. Patent Publication 2002/0076255 (hereinafter "Hoang"). Applicants respectfully traverse this rejection.

Claim 2 is directed to an applicator/dispenser assembly for dispensing and/or applying a polymerizable monomeric adhesive material. The assembly comprises a first body portion and a second body portion, at least one of the first and second body portions being movable relative to the other of the first and second body portions; a cavity in at least one of the first and second body portions; and a piercing or breaking member arranged on the first body portion. Movement of one of the first and second body portions relative to the other of the first and second body portions moves the piercing or breaking member into the cavity. The piercing or breaking member comprises at least two opposing members such that both opposing members are moved into the cavity upon movement of one of the first and second body portions relative to the other of the first and second body portions.

Independent claim 3 is directed to an applicator/dispenser assembly for dispensing and/or applying a polymerizable monomeric adhesive material, comprising a first body portion and a second body portion, at least one of the first and second body portions being movable relative to the other of the first and second body portions; an open space at least partially in and between the first and second body portions; and a piercing or breaking member arranged on the first body portion. Movement of one of the first and second body portions relative to the other of the first and second body portions moves the piercing or

breaking member into the open space at least partially in and between the first and second body portions. The applicator/dispenser further comprises a container of adhesive material at least partially disposed within the open space at least partially in and between the first and second body portions, wherein movement of one of the first and second body portions relative to the other of the first and second body portions moves the piercing or breaking member to rupture the container.

Claim 20 is directed to an applicator/dispenser assembly for dispensing and/or applying a polymerizable monomeric adhesive material, comprising a first body portion and a second body portion, at least one of the first and second body portions being movable relative to the other of the first and second body portions; a cavity in at least one of the first and second body portions; and a piercing or breaking member arranged on the first body portion. Movement of one of the first and second body portions relative to the other of the first and second body portions moves the piercing or breaking member into the cavity, and the second body portion is rotatable relative to the first body portion. The applicator/dispenser further comprising a camming surface arranged on the second body portion wherein rotation of the second body portion relative to the first body portion moves the piercing or breaking member into the cavity by contacting the camming surface and the piercing or breaking member.

Claim 22 recites an applicator/dispenser assembly for dispensing and/or applying a polymerizable monomeric adhesive material, comprising a first body portion and a second body portion, at least one of the first and second body portions being movable relative to the other of the first and second body portions; a cavity in at least one of the first and second body portions; and a piercing or breaking member arranged on the first body portion. Movement of one of the first and second body portions relative to the other of the first and second body portions moves the piercing or breaking member into the cavity. The applicator/dispenser further comprises a bladder disposed at least partially within the cavity, at least a portion of the bladder being flexible; and a container of adhesive material disposed within the bladder and at least partially located in the cavity, wherein movement of one of the first and second body portions relative to the other of the first and second body portions moves the piercing or breaking member to rupture the container.

Hoang is directed to a skin disinfectant applicator. The applicator includes a generally hollow handle, a foam pad attached to the hollow handle, an ampoule that holds the

anti-microbial prep solution and a means for opening the ampoule. *Paragraph [0008]*. The means for opening the ampoule can take many forms such as a lever located on the hollow handle, a portion of the hollow handle can be squeezed by the clinician to contact and break the ampoule or a movable button may be located on the hollow handle. *Paragraph [0008]*.

The Office Action refers to Figs. 14-17 in the rejection of the claims over Hoang.

According to the Office Action:

Regarding claim 2, the Hoang et al. reference discloses an applicator/dispense assembly (Figs. 14-17) that is capable of being used to apply a polymerizable monomeric adhesive material. The assembly includes a first body portion (constitute by the handle) and a second body portion (constitute by the portion with element 30). The first and second body portions are movable relative to one another. A cavity forms in at least one of the first and second body portions. A breaking member (24) arranged in the first body portion (Fig. 15), wherein movement (when the portions assembled) of one of the body portions moves the breaking member in to the cavity.

*Office Action mailed November 17, 2006, pages 5-6 (emphasis added).*

As described above, for each of the rejected independent claims, movement of the first and second body portions relative to each other moves the piercing or breaking member such that an adhesive container may be ruptured. Hoang does not describe movement of any first and second body portions relative to each other which results in any breaking member moving to rupture a container. As described in paragraph [0043] of Hoang, the means for opening ampoule 25 in FIGS. 14-17 involves application of force by the clinician to a flexible portion of the walls of the hollow handle. This force is transmitted to an internal rib adjacent to the frangible portion of ampoule 25. The internal rib in turn contacts and breaks ampoule 25. Thus, this body portion is moved at the time the ampoule is broken irrespective of element 30. The second body portion as identified in the Office Action, element 30, is merely a foam pad. No movement of a first body portion relative to the foam pad results in breaking the ampoule as described in Hoang.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Hoang lacks at least first and second body portions of the rejected claims as well as the feature reciting the relative movement of those body portions to move the piercing or breaking member as claimed in each of the independent claims detailed above. Thus, Hoang

does not disclose each and every feature of the rejected claims. In view thereof, Hoang does not anticipate the invention as defined in the rejected claims and Applicants respectfully request that this rejection be withdrawn.

#### **VI. REJECTIONS UNDER 35 U.S.C. § 103**

Claims 6-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoang et al. Applicants respectfully traverse this rejection.

The rejected claims are each directed to an applicator/dispenser assembly. Each rejected claim recites structure wherein movement of one of a first and second body portion relative to the other of the first and second body portion moves the piercing or breaking member into a cavity. As discussed above, Hoang completely lacks disclosure of such a structure. Moreover, there is nothing in Hoang which would have motivated one of ordinary skill in the art to modify the structure of Hoang to provide the applicator/dispenser assembly of the rejected claims. Rather, given that the "second" body portion as indicated by the Office Action is foam pad 30, movement of the handle relative to the foam pad would not result in any action which is capable of moving a breaking member into a cavity. In view thereof, the rejected claims would not have been obvious to one of ordinary skill in the art from Hoang and Applicants respectfully request that this rejection be withdrawn.

Claims 37-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoang et al. in view of Voiers et al., U.S. Patent No. 6,425,704. Applicants respectfully traverse this rejection.

Independent claim 37 is directed to a kit comprising at least one applicator/dispenser for dispensing and/or applying a polymerizable monomeric adhesive material. The kit comprises a first body portion and a second body portion, at least one of the first and second body portions being movable relative to the other of the first and second body portions; a cavity in at least one of the first and second body portions; and a piercing or breaking member arranged on the first body portion, wherein movement of one of the first and second body portions relative to the other of the first and second body portions moves the piercing or breaking member into the cavity. A plurality of containers of adhesive material is arranged to be placed at least partially in the cavity of the at least one applicator/dispenser, wherein movement of one of the first and second body portions relative to the other of the first and

second body portions moves the piercing or breaking member to rupture one of the containers that is placed at least partially in the cavity.

Hoang is described above. As noted, Hoang completely lacks disclosure of a structure wherein movement of one of the first and second body portions relative to the other of the first and second body portions moves the piercing or breaking member to rupture one of the containers that is placed at least partially in the cavity.

Voiers et al. relates to an applicator for dispensing adhesive material which includes a container body holding the adhesive material and an applicator tip. In certain embodiments, the applicator includes a container body, a container of adhesive material contained in the container body, a shaped body of porous material, wherein the adhesive material is located in the container body in a noncontacting relationship with the porous material prior to dispensing the adhesive material, at least one breaking means located on the porous material for breaking or rupturing the container of adhesive material, and an applicator tip. *Column 3, line 63 – column 4, line 5.*

According to the Office Action, Voiers et al. is cited as disclosing a plurality of containers and applicator tips forming a kit. Even if Voiers et al. contained such disclosure, Voiers et al. does not remedy the deficiencies of the disclosure of Hoang. Therefore, the combination of Hoang and Voiers et al. would not have made the kits as defined in the rejected claims obvious to one of ordinary skill in the art. In view thereof, Applicants respectfully request that this rejection be withdrawn.

## **VII. WITHDRAWN CLAIMS**

Claims 17, 18 and 29-36 have been withdrawn pursuant to a species election. However, because these claims all ultimately depend from generic claims that are now believed to be allowable, Applicants respectfully request that the claims to the non-elected species be rejoined, examined and allowed. As noted in the Office Action mailed November 16, 2004, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claims as provided by 37 C.F.R. § 1.141.

For the foregoing reasons, claims 2-18, 20-44 and 51-52 are considered allowable. A Notice to this effect is respectfully requested. If any questions remain, the Examiner is invited to contact the undersigned at the number given below.

Respectfully submitted,

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Date: February 16, 2007

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